

REMARKS

Introduction

In response to the Office Action dated February 28, 2008, Applicants have amended claim 1. Care has been taken to avoid the introduction of new matter. Claim 4 is withdrawn. In view of the foregoing amendments and the following remarks, Applicants respectfully submit that all pending claims are in condition for allowance.

Entry of Amendment under 37 C.F.R. § 1.116

The Applicants request entry of this Rule 116 Response. Support for amended claim 1 is found in, for example, pg. 12, lines 12-15 and pg. 18, lines 1-6 and Fig. 4. There are no new issues presented. As will be explained below, the claim amendments place the application in condition for allowance. Moreover, the Manual of Patent Examining Procedure sets forth in Section 714.12 that “any amendment that would place the case either in condition for allowance or in better form for appeal may be entered.” Entry of this claim amendment is respectfully requested.

Claim Rejection Under 35 U.S.C. § 103

Claims 1, 3, 5, 6, 8, and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,015,785 to Ikegami et al. (hereinafter Ikegami) in view of U.S. Patent No. 5,558,296 to Sasaki et al. (hereinafter Sasaki). Applicants traverse.

Amended claim 1 recites, in part, “...an engagement portion *extending from the inner peripheral surface*.”

The Office Action asserts that Ikegami discloses an apparatus for winding a wire including an annular guide 10 for guiding the wire, the guide having an inner peripheral surface 10a whose diameter gradually increases in a direction remote away from the bobbin, and is disposed so that it can cover one of the collars 5 of a take-up bobbin 1 for the wire. The Examiner avers that the annular guide is movably positioned to cover one of a plurality of collars of the take-up bobbin for the wire. The Examiner contends that Ikegami discloses an engagement portion corresponding to *the space between the angled part and the part parallel to the bobbin collar* as shown by the dashed line in Fig. 6.

Ikegami fails to disclose or suggest, an engagement portion *extending from the inner peripheral surface*, as required by amended claim 1. Rather, the technique described in Ikegami requires both the main terminal treating cover 9 and the auxiliary terminal treating cover 10 to prevent the wire from becoming interlaced or entangled with the take-up bobbin. Further, the Examiner concluded that the engagement portion is the *space* between the angled part and the part parallel to the bobbin collar as shown by the dashed line in Fig. 6, which cannot extend from the inner peripheral surface.

Ikegami states in col. 6, lines 7-28:

The terminal end of the wire-like object 2 thus severed is caused to engage the walls 9a and 10a in a manner shown, for example, within Figs. 3, 5 and 6, and *is subsequently guided within a terminal accommodating space defined by means of the covers 9 and 10*, and by the guide surfaces thereof, whereby the movement of the terminal end of the wire-like object is terminated without being damaged. In addition, as the travelling path of the wire-like object 2 is regulated by means of the covers 9 and 10 in such a manner that the wire-like object is spaced from the pawls 12 of the full bobbin 1, *the wire-like object 2 is effectively prevented from becoming interlaced or entangled with such structure*. Still further, as the opening for leading the wire-like object 2 outwardly or exteriorly of the bobbin 1 is not maintained in the opened condition at all times, and in addition, as *the opening defined by means of the covers 9 and 10 does not oppose the wire-like object 2 and impart resistance thereto, the wire-like object is*

prevented from being partially cut whereby such cut particles would normally scatter outwardly inflicting additional damage to the apparatus (*emphasis added*).

Therefore, the annular guide of Ikegami cannot employ either the cover 9 or cover 10, it must employ both covers. Further, the alleged engagement portion of Ikegami is a *space* between covers 9 and 10, as admitted by the Examiner, and does not extend from the inner peripheral surface.

Ikegami fails to disclose or suggest, at a minimum, “...an engagement portion *extending from the inner peripheral surface*,” as recited in amended claim 1. Ikegami fails to disclose or suggest, at a minimum, “...engaging the cut terminal portion of the wire with an engagement portion provided *on* the annular guide,” as recited in independent claim 8.

The annular guide of the present claimed subject matter prevents the wire from springing out of the take-up bobbin using the engagement portion extending from the inner peripheral surface of the annular guide without using two covers, which is disclosed in Ikegami. In order to achieve this construction, it is necessary to provide a notch for guiding the wire to the annular guide.

The Office Action acknowledges that Ikegami is silent regarding the annular guide having a notch. The Office Action relies on Sasaki in an attempt to cure the deficiencies of Ikegami.

The Office Action asserts that Sasaki discloses an annular guide 24 with a notch 24a for guiding a wire onto a take-up bobbin 12. The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to add the notch of Sasaki to the annular guide of Ikegami to guide the wire onto the bobbin as taught by Sasaki.

Sasaki shows, in Fig. 1, a notch-like opening 24a provided on an end cover 24. An inner peripheral surface of the annular guide 24 of Sasaki has a *constant diameter*, as shown in Figs. 1,

6, 8, and 10. Therefore, the annular guide 24 of Sasaki is not provided with an inner peripheral surface whose diameter *gradually increases* in a direction away from the take-up bobbin, as required by amended claim 1. Although not relied upon to do so, Sasaki fails to disclose or suggest, an inner peripheral surface of the annular guide having a diameter that gradually increases, as required by claims 1 and 8.

Sasaki states in col. 10, lines 53-55:

As noted from Figs. 3 and 4, the elongated member 1 is introduced out of the end cover 24 through the notch-like opening 24a.

Since Sasaki does not have a sloped inner peripheral surface with an engagement portion extending therefrom, it is difficult to hold the cut terminal portion of the wire and prevent the cut terminal portion from springing around. Sasaki relies on the elongated member pinching section found between the annular guides (24, 24') to prevent the terminated portion of the elongated member from "running widely" and introduces it into the end or second cover.

Sasaki in col. 12, lines 29-42:

Since the elongated member pinching section 36 in the form of pinch rolls or pressure rolls 44 and 44' has a damping action and there is a slack of the elongated member 1 produced on the downstream side of the pressure rolls 44 and 44' and absorbed by the looper 130, the elongated member 1 on the spool 12 on which it is fully wound is prevented from being adversely affected by the excessive tension applied to the upstream portion of the elongated member 1. Thus, it will be noted that the elongated member 1 on the spool 12 on the already operating spooler 10 is never damaged or broken by the upstream tension produced when the elongated member 1 is caught and cut at the waiting spooler 10'.

Ikegami discusses guiding the wire-like object into the cover by moving the covers (9, 10) closer to each other, thus do not need a notch. On the other hand, Sasaki requires treating the cut terminal portion of the wire with the notch *and* the elongated member pinching section. Therefore, one of skill in this art would not have been motivated to guide the cut terminal portion of the wire to add a notch when the annular guide uses two covers to move the wire.

The Examiner's position that it would have been obvious to one of ordinary skill in the art to substitute the technique of Sasaki in Ikegami is **illogical and inconsistent**. There is **no factual basis** upon which to predicate the determination that the methodology employed by each of Ikegami and Sasaki **necessarily** results in a method and apparatus corresponding to that claimed, particularly employing an annular guide having a notch **and** an engagement portion extending from or on the inner peripheral surface. Specifically, Ikegami describes guiding the wire with both covers, however, Sasaki discusses treating the cut terminal portion of the wire with a notch **and** an elongated member pinching section, so there is no basis for alleging obviousness thereof. Therefore, Sasaki cannot be relied upon to cure the deficiencies of Ikegami.

As, Ikegami and Sasaki do not disclose the same apparatus and method for winding a wire as disclosed by the present inventors, Ikegami and Sasaki do not teach or remotely suggest the apparatus and method for winding a wire, as required by claims 1 and 8.

Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). There is no suggestion in Ikegami to modify the annular guide to have a notch, nor does common sense dictate the Examiner-asserted modifications. The Examiner has not provided any evidence that there would be any obvious benefit in making the asserted modification of Ikegami. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

The only teaching of the claimed apparatus and method for winding a wire is found in Applicants' disclosure. However, the teaching or suggestion to make a claimed combination and the reasonable expectation of success must not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Withdrawal of the foregoing rejection is respectfully requested.

Conclusion

In view of the above amendments and remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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